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Supreme Court of the United States

OCTOBER TERM, 1966

No. [redacted] 46

EDWARD J. BRENNER, Commissioner of Patents,
Petitioner,

v.

JACK H. HOFSTETTER

On Petition for a Writ of Certiorari to the United States Court of Customs and Patent Appeals

BRIEF IN OPPOSITION

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BRIEF FOR THE RESPONDENT IN OPPOSITION TO PETITION FOR CERTIORARI

INTRODUCTION

No question is raised by the decision of the court below to justify the review requested by the petition herein. The question posed by the petition is a hypothetical one only and is not warranted on the basis of the decision below. The Court of Customs and Patent Appeals did not hold that the appellant therein was entitled to a patent "merely (because) there is room to doubt the correctness of the administrative determination" as the petitioner's question suggests. On the

contrary, the court specifically recognized that the invention at issue could not be realized from the cited prior art except "through hindsight".* While the so-called "rule of doubt" was referred to by the court below in reaching its decision, this "rule" is obviously in no sense equivalent to saying that an administrative finding will be reversed "merely" because there is "room to doubt" that finding. There is no inconsistency between the "rule" and the long established practice of the Court of Customs and Patent Appeals to affirm decisions of the Patent Office on technical questions unless these are manifestly in error. There also is no factual showing of any substantive inconsistency between the practice and standards of the Court of Customs and Patent Appeals and those of the District Court or the Court of Appeals for the District of Columbia, bearing in mind especially the totally different types of appeals involved in these courts, i.e., review limited to the Patent Office record in the Court of Customs and Patent Appeals and trial de novo in the District Court.

STATEMENT

While the Statement in the petition may be accepted in part, certain corrections and clarifications are necessary.

The Patent Office has not questioned either novelty or utility of respondent's invention (i.e., under 35 U.S.C. 102). The sole issue relates to obviousness and the requirements of 35 U.S.C. 103.

Petitioner quotes the true finding of the court below that it was "doubtful that appellant's invention would

* Petition Appendix, page 18, first full paragraph.

have been obvious to one of ordinary skill in the art from the teachings of record other than by employing hindsight reasoning". However, exception is taken to petitioner's assertions which follow, i.e., that the "rule of doubt" applied by the court below is one "whereby *all doubts* as to patentability are resolved in favor of the applicant," (emphasis added throughout) or that it was on any basis of *"all doubt"* resolution that the court below reversed the rejection of the claims. Those are petitioner's words and not those of the court.

The opinion below summarizes its reasons for the expression of doubt in the supporting finding (petition appendix p. 18) that:

> "It seems that the relevance of Sherman to the blow molding art, viewed in combination with Haines or Negoro is not appreciated until appellant's invention is examined. Thus appellant's invention is realized *only through hindsight*. This we may not do."

REASONS FOR DENIAL OF WRIT

I. The "Question" Proposed by Petitioner Finds No Basis in the Decision Below and Therefore Fails to State an Issue Warranting Review.

The court below did not hold and has never held that it resolves "all doubts" against the administrative ruling on patentability or that such ruling should be reversed "merely" because "there is room to doubt" the correctness of the determination as the petition suggests. The question proposed by the petitioner is, therefore, completely hypothetical, is not warranted by the decision below and gives no valid issue warranting the requested review. The petition should be denied for this reason alone.

2. The "Rule of Doubt" Used by the Court Below Gives No Basis for Review. The "Rule" Only Defines the Court's Own Thought Processes When Determining the Issue of Obviousness and Is By No Means in Conflict With a Presumption of Administrative Correctness.

The Court of Customs and Patent Appeals always has recognized that its fundamental statutory obligation under 35 U.S.C. Section 103 and 144 is to *review* Patent Office decisions on questions of obviousness. While the court has referred to a "rule of doubt" favoring the applicant in the present case, as it has done in many cases in the past, the court is merely describing in its words the thought processes of any court which, if not inevitably, at least commonly, involve entertaining, rejecting and resolving doubts to the conclusions reached. Surely, the court below may employ whatever thought processes, including application of its so-called "rule of doubt", that seem appropriate to the circumstances, provided the ultimate decision answers the question as to obviousness under the statutory standard of 35 U.S.C. 103.

Nothing found in the Statute precludes appellate court expressions of doubt against the merits of an appellant's case or of putting reversal on the basis of resolution of doubts for him where, as here, those doubts are *sufficiently strong* to warrant reversal. The Statute does not contemplate the impossibility of dictating thought processes.

The term "rule of doubt" applied by the court below had its birth in an era when the Court of Customs and Patent Appeals was not regarded as part of the federal judiciary and has long existed in that court coextensively with a presumption of administrative correctness. For example, the burden of proof in the Court

of Customs and Patent Appeals has consistently been placed on the applicant. *In re Taylor*, 92 F.2d 705, 706; *Application of May*, 172 F.2d 593, 599; *In re Allatt*, 121 F.2d 545, 551; *Application of Haney*, 158 F.2d 296, 298. In *In re Wuerts*, 110 F.2d 854, 857, the court expressed its rule on the weight given Patent Office decisions as follows:—

> "The issue presented involves highly technical factual matters, and it is well settled that in cases of this character concurring decisions of the tribunals of the Patent Office will not be disturbed, unless it appears that they are manifestly wrong. *In re Henry Anhaltzer*, 48 F.2d 657, 18 C.C.P.A., Patents 1181 and cases therein cited; *Berman v. Rondelle*, 75 F.2d 845, 22 C.C.P.A. Patents 1049".

Again, in *Application of Allbright*, 152 F.2d 984, 986, that court said:

> "The issue presented is highly technical in character and the rule (is) that in cases involving highly technical questions the decisions of the Board of Appeals will not be disturbed unless manifestly erroneous. . . ."

Essentially the same rule has been stated in numerous other cases in that court, for example: *In re Bertsch*, 132 F.2d 1014, 1016; *In re Bertsch*, 107 F.2d 828, 831; *In re Carlton*, 111 F.2d 190, 192; *In re Taylor*, 92 F.2d 705, 706; *Application of Smith*, 161 F.2d 274, 278; *In re Buser*, 129 F.2d 710, 713; *Application of Hertrich*, 161 F.2d 223, 225; *Application of Schechter*, 205 F.2d 185, 188; *In re Hoover*, 159 F.2d 763, 765.

Indeed the Court of Customs and Patent Appeals has expressly held its own jurisdiction limited to "re-

view" rather than considering the case independently of the Patent Office. Thus, in *Application of Mork*, 155 F.2d 276, 280, the court said:

> "Hereinbefore we have quoted appellant's suggestion to the effect that we disregard the action of the examiner and the board and 'start from scratch' in comparing the claims and the references. The suggestion is somewhat novel to say the least of it. It would seem to require that the court assume the functions of the Primary Examiner which we may not do. The statute defines our duty and limits our authority. We are required to review the decision of the board affirming the decision of the examiner when that decision is adverse to an appellant, and our review must be confined to the errors alleged in the reasons of appeal. Obviously, we cannot disregard a decision and at the same time review it."

Petitioner presents a question for consideration here based on a misunderstanding of the proceedings of the Court of Customs and Patent Appeals. Perhaps that court chooses to express its manner of arriving at judgments, in the category of cases entrusted to its limited jurisdiction, in terms of what it calls a "rule of doubt". But this is merely a matter of semantics in attempting to express the thought processes leading to the ultimate decision. This Court's certiorari jurisdiction should not be invoked merely to rephrase the opinions of the Court of Customs and Patent Appeals.

3. However the District Court for the District of Columbia and the Court of Appeals for the District of Columbia Circuit Express Their Bases for Reasoning, There Is No Showing That They Do Not Both Apply the Same Standards of Invention as the Court of Customs and Patent Appeals.

The rule in the District Court was expressed in *Commonwealth Engineering Co. of Ohio* v. *Watson, Commissioner of Patents*, 188 F. Supp. 544, 546, as follows:

> "A great deal of weight must necessarily be attached to the conclusions of the Patent Office. That is true of the decisions of any administrative agency. It is particularly true of the Patent Office in respect to those matters that are of a highly technical and scientific nature as this one is."*

This is consistent with the position of the Court of Customs and Patent Appeals in *In re Wuertz, supra.* Bearing in mind that the Court of Customs and Patent Appeals has "the special competence in complex technical . . . matters that comes from narrowly focused inquiry," *Glidden* v. *Zdanok*, 370 U.S. 530, 560, there is no basis for saying that the "rule of doubt" referred to by it is anything more than the proper exercise of its appellate jurisdiction. Were that court to apply any different rule, it would place the Patent Office beyond all review by the courts. Such a result would be

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* Significantly, a different rule is applied by the District Court in nontechnical matters, such as trademarks. In *Daggett and Ramsdell* v. *Marzall, Commissioner of Patents*, 128 F. Supp. 906, 908, that court said:

> "A long standing and consistent policy of this Court is to accord considerable respect to the rulings of the Patent Office. Such rulings will not be overturned unless shown to be clearly erroneous or new and substantial evidence is offered . . . At the same time the Court is entitled to rely more heavily on its own judgment where the case, as here, does not involve an intricate scientific problem."

grossly improper. *Great Atlantic and Pacific Tea Company* v. *Supermarket Corporation*, 340 U.S 147, 153-156. The Court of Customs and Patent Appeals is a court, composed of judges, who are called upon to make judicial determinations. It now is a part of the Federal Judiciary, *Glidden* v. *Zdanok, supra.* It is not authorized to decide abstract questions of law but is charged with judging cases and controversies. In its appellate role, it necessarily "reviews", but in doing so it exercises judgment. The techniques it uses to make these judgments are not inconsistent with its presumption of administrative correctness.

4. Inevitability of an Element of Doubt in All Determinations of Obviousness.

As recently as *Graham* v. *John Deere Co.*, 383 U.S. 1, this Court observed at p. 18:

> "This is not to say, however, that there will not be difficulties in applying the non-obviousness test. What is obvious is not a question on which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development."

Judicial experiences have recognized the inevitability of doubts which must be dealt with, but not according to any policy of which respondent is aware, that would reject a cause simply because it involves an element of doubt. Justice and fairness do not require that for an appellate cause to be immune to reversal it must be free of *all* doubt, where the facts can support thorough conviction notwithstanding some doubt. To hold otherwise would require that the appellate court abandon

its review function (in this case specifically required by 35 U.S.C. 144) and automatically affirm the decision below.

The petition presents no showing that the Court of Customs and Patent Appeals (following *Graham* v. *John Deere Co., supra* as it does, *In re Dailey et al.*, 357 F.2d 669, 673) has in fact failed to recognize and apply appropriate standards of invention, or that those standards are being maintained to any greater degree by the Court of Appeals for the District of Columbia Circuit, the District Court for the District of Columbia or the Patent Office. Its so-called "rule of doubt" can apply to a higher as well as to a lower standard of invention, while at the same time giving proper respect to the administrative decisions of the Patent Office.

5. The Responsibility of the Patent Office in Examining Patent Applications.

Ultimately the efforts of the Patent Office in examining applications must be directed at establishing whether there is a factual basis for a conclusion of unpatentability *Graham* v. *John Deere Co., supra,* at pp. 17-18. Decision must rest on whether that has been done in this case, proper weight being given to the presumption that it has.

Respondent does not desire to enter into what is asserted to be a conflict between courts of competing jurisdiction but which in reality is nothing more than a matter of semantics. His desire is to obtain a patent in exchange for disclosing to the public a meritorious invention. Respondent consistently has urged the patentability of his invention solely on the lack of any

substantial evidence in the record to support a conclusion of obviousness, under any standard of invention. And the petition charges no error by the Court of Customs and Patent Appeals in finding a basic inconsistency in the Patent Office's reasoning from the facts.

Stripped of *obiter dicta*, the decision below defines a simple issue. The respondent has made improvements in methods and apparatus for blow molding plastic bottles whose large diameters gave rise to special problems, apparently first recognized by respondent, in obtaining uniform wall thicknesses. The Patent Office first cited two prior patents, Haines and Negoro, which in the absence of any indications to the contrary, were concerned with the making of ordinary or relatively small size containers. An important element of the present controversy is that those patents *asserted* that their techniques produced bottles of *uniform thickness.** Respondent's explanation to the Patent Office that his invention solved problems in the blowing of large diameter containers, and that it employed specifically claimed different means for those accomplishments, produced citation of a third reference, Sherman, which had nothing to do with blow molding of anything (or a uniform wall thickness product of any kind) and whose possible relevance could only have resulted from hindsight relation to respondent's teachings.

In essence, respondent Hofstetter's invention is predicated upon the discovery that bottles blown to large

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*Uniformity is rather important. A bottle is only as strong as its thinnest portion (like a chain which is only as strong as its weakest link). Thus, sufficient plastic must be used so that every part of the bottle is strong enough. If the bottle is not uniform, some portions will contain more than the thinnest portion, i.e., more than they need, and plastic is wasted.

diameters as by Haines and Negoro, would not *in fact* be uniform in wall thickness. The petitioner has not challenged that this is correct; and *the Patent Office never produced any evidence that the need for departure from Haines or Negoro was recognized or obvious.* As to unobviousness of the method and apparatus employed by Hofstetter pursuant to his discovery, the only evidence on this point was the argument that if one chose to modify Haines and Negoro to arrive at Hofstetter, the way was indicated by Sherman. But in any realistic sense Sherman could not possibly have taught or suggested any blow molding variations of the other references *because Sherman was not concerned with blow molding anything to uniform wall thickness,* a factual appraisal recognized by the Court of Customs and Patent Appeals.

This Court has considered patents of this type many times before. Thus in *Goodyear Tire and Rubber Co.* v. *Ray-O-Vac,* 321 U.S. 275, 279, it was said

> "Viewed after the event, the means . . . adopted seems simple and such as should have been obvious to those who worked in the field, but this is not enough to negative this invention."

The same reasoning was applied in *Eibel Process Co. of Minnesota* v. *Ontario Paper Co.,* 261 U.S. 45, 67, 68. These decisions merely follow the principle of *Webster Loom Co.* v. *Higgins,* 105 U.S. 580, where it was said at page 591

> "Now that it has succeeded, it may seem very plain to anyone that he could have done it as well. This is often the case with inventions of the greatest merit."

The petitioner has never contradicted the facts as described above, not during proceedings in the Patent

Office, not in the Court of Customs and Patent Appeals and not in his petition in this Court. Yet he holds it to be obvious to modify a known machine for a purpose (large containers) undisclosed in the prior art, so that the plastic bottles produced will be of uniform thickness for that purpose, when the only evidence on the issue of obviousness, Haines and Negoro, say that their techniques *make uniform bottles,* presumably of usual (small) sizes, and Sherman is unconcerned with such objectives. Once the respondent Hofstetter showed both the need and means for its realization, his may seem departures from the prior art simple enough. But under no rule of law has this ever been sufficient to defeat invention.

8. Summary.

The petition fails to state a reviewable question based on the decision below and makes no showing (1) that the merits of the appeal below did not in fact warrant reversal of the Patent Office, or (2) that the proper standards of invention are not being applied by the Court of Customs and Patent Appeals, or (3) that there can be any realism in proposing to exclude all elements of doubt from judicial thinking in arriving at just decisions.

CONCLUSION

The petition for writ of certiorari should be denied.

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OCTOBER TERM, 1967.

BRENNER, COMMISSIONER OF PATENTS *v.* HOFSTETTER.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

No. 46. Decided October 9, 1967.

PER CURIAM.

Upon consideration of the respondent's suggestion of mootness the judgment is vacated and the case is remanded to the United States Court of Customs and Patent Appeals with directions to dismiss the appeal to that Court as moot.

MR. JUSTICE MARSHALL took no part in the consideration or decision of this case.